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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,118

**Applicant(s)**

DUNCAN ET AL.

**Examiner**

JAMES J. DEBROW

**Art Unit**

2176

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to communication: Amendment filed 17 Dec. 2009.

Claims 1-21, 30 and 31 are pending in the case. Claims 1, 7, 13 and 15 are independent claims.

### ***Applicant's Response***

In Applicant's Response dated 17 Dec. 2009, Applicant amended claims 1-15, 17 and 18; added new claims 30 and 31; argued against all rejections previously set forth in the Office Action dated 21 Jul. 2009.

### ***Examiner's Note***

In regards to Applicant's amendments to the independent claims 1, 7, 13 and 15 to recites unmarked-up document, the Examiner concludes that the specification does not recite the amended claim language. For the purpose of a prior art rejection, based on the disclosure within the specification, page 5, lines 25-26 of the current invention, the Examiner interprets unmarked-up document to be the "output document".

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 7-11** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*Claims 7-11:*

In summary, Claim 7 recites a “*method of producing a document*” comprising steps that may be performed manually and/or mentally. Thus, the recited method is not tied to a particular machine or apparatus. According, the recited method is nonstatutory subject matter.

Claims 8-11 fails to further define the recited method as statutory subject matter as defined in 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Reulein et al. (Pat. No. US 7,035,837 B2; Filed Jan. 30, 2002) (hereinafter “Reulein”).**

**Regarding independent claim 1, Reulein discloses a *system for producing a document comprising:***

*a repository for storing documents in a marked-up form according to one or more mark-up schemas, each marked-up document having explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up document* (col. 2, lines 24-26; col. 3, lines 19-27; col. 4, lines 12-15; col. 6, lines 49-63; col. 7, lines 14-30; Reulein discloses a repository for storing XML document component and XML completed document which can be assembled into a document. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up/output document.).

*a document format store for storing formats* (col. 2, lines 24-26; col. 3, lines 19-27; Reulein discloses a repository for storing XML document component and published document in one or form formats.).

*a document production processor for generating a user-requested document from said marked-up documents using a user-selected one of said formats, said generated user-requested document retaining said implicit structural information* (col. 4, lines 6-18 & 37-44; col. 8, lines 4-59; Reulein discloses selecting a publication format for the publication. The documents may be published in a variety of industry standards formats including postscript, PDF, HTML, XML and metacode.).

**Regarding dependent claim 2,** Reulein discloses *the system of claim 1, wherein each said mark-up schema includes minor structural mark-up elements which must flow in said generated user-requested document* (col. 4, lines 19-29; Reulein

discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document.).

**Regarding dependent claim 3**, Reulein discloses *the system of claim 2, wherein said minor structural mark-up elements include one or more of words, characters, paragraphs, numbered paragraphs or special paragraphs* (col. 4, lines 19-29; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. The DTD may mandate that certain section of a document contain a traditional paragraph structure.).

**Regarding dependent claim 4**, Reulein discloses *the system of claim 1, wherein each of said formats includes a set of rules having parameters capable of user replacement* (col. 4, line 63-col. 5 line 7; col. 6 lines 26-48; col. 9 line 8-col. 11 line 3; Reulein discloses formats are a set of rules having parameters capable of user replacement.).

**In regards to independent claim 7**, Reulein discloses *a method of producing a document comprising the steps of:*  
*marking-up a document according to a schema the marked-up document having explicit corresponding to implicit structural information contained in a corresponding*

*unmarked-up document* (col. 4, lines 19-29; col. 7, line 14 – col. 8, line 47; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. Reulein also disclose the user editing/marking up a XML document/component. The XML components are mapped to the appropriate Document Type Definition (DTD) and/or schema. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up/output document.).

*applying a user-selected format to said marked-up document* (col. 4, lines 19-29; col. 7, line 14 – col. 8, line 47; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. Reulein also disclose the user editing/marking up a XML document/component. The XML components are mapped to the appropriate Document Type Definition (DTD) and/or schema.).

*generating a user-requested document using said user-selected format, said user-requested generated document retaining said implicit structural information* (col. 4, lines 19-29; col. 7, line 14 – col. 8, line 47; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. Reulein also disclose the user editing/marking up a XML document/component. The XML components are mapped to the appropriate Document Type Definition (DTD) and/or schema. Reulein further discloses an assembly subsystem that assembles documents into completed

XML formats.).

**Regarding dependent claim 8**, Reulein discloses *the method of claim 7, wherein each said schema includes minor structural mark-up elements which must flow in said generated user-requested document* (col. 4, lines 19-29; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document.).

**Regarding dependent claim 9**, Reulein discloses *the method of claim 8, wherein said minor structural marked-up elements include one or more of words, characters, paragraphs, numbered paragraphs or special paragraphs* (col. 4, lines 19-29; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. The DTD may mandate that certain section of a document contain a traditional paragraph structure.).

**Regarding dependent claim 10**, Reulein discloses *the method of any claim 7, wherein each of said user-selected formats includes a set of rules having parameters capable of user replacement* (col. 4, line 63-col. 5 line 7; col. 6 lines 26-48; col. 9 line 8-col. 11 line 3; Reulein discloses formats are a set of rules having parameters capable of user replacement.).



**Regarding dependent claim 30,** Reulein discloses *the system of claim 1, wherein each of said formats includes a set of rules having user-specified parameters* (col. 4, line 63-col. 5 line 7; col. 6 lines 26-48; col. 9 line 8-col. 11 line 3; Reulein discloses formats are a set of rules having parameters capable of user replacement, deletion or insertion of variable text and variable data.).

**Regarding dependent claim 31,** Reulein discloses *the method of claim 7, wherein said user-selected format includes a set of rules having user-specified parameters* (col. 4, line 63-col. 5 line 7; col. 6 lines 26-48; col. 9 line 8-col. 11 line 3; Reulein discloses formats are a set of rules having parameters capable of user replacement deletion or insertion of variable text and variable data.).

#### **NOTE**

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reulein in view of Hendrickson et al. (Pub. No. US 2002/0065852 A1; Filed: Nov. 30, 2000) (hereinafter "Hendrickson").**

**Regarding dependent claims 5 and 11,** Reulein does not expressly disclose *the system of claim 4 and the method of claim 10 respectively, wherein said parameters are applied by the document production processor to generate the user-requested document with any one or more of: variable paragraph or word shapes, variable paragraph spacing, variable character height, variable character width, variable font colour, variable background colour, use of colour for differing classes of words, variable character density, variable margin sizes, use of optically corrected font, use of shaded font, variable line length, variable line spacing, use of separators between lines of text and use of patterns in characters or words.*

Hendrickson teaches *wherein said parameters are applied by the document production processor to generate the user-requested document with any one or more of: variable paragraph or word shapes, variable paragraph spacing, variable character height, variable character width, variable font colour, variable background colour, use of colour for differing classes of words, variable character density, variable margin sizes, use of optically corrected font, use of shaded font, variable line length, variable line*

*spacing, use of separators between lines of text and use of patterns in characters or words* (0027-0030; Hendrickson teaches custom setting features which allows the user to change formatting parameters such as font type, font size, text justification, margins and other layout setting.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Hendrickson with Reulein for the benefit of allowing a user to dynamically change the style of an online document (0007).

**NOTE**

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

**Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reulein in view of Gebert et al. (Pub. No. US 2002/0111963 A1; Filed: Feb. 14, 2001) (hereinafter “Gebert”).**

**Regarding dependent claim 6, Reulein does not expressly disclose *the system of any one of the preceding claims, wherein said marked-up documents and said***

*formats are in the form of XML files, and said production processor creates an XML:FO style sheet from said XML format file, creates an XML:FO file from said XML document and said style sheet, and generates an output file from said XML:FO file representing said user-requested document.*

Gebert teaches *marked-up documents and said formats are in the form of XML files, and said production processor creates an XML:FO style sheet from said XML format file, creates an XML:FO file from said XML document and said style sheet, and generates an output file from said XML:FO file representing said user-requested document* (0005-0008; 0014; 0023; 0030; 0042; Gebert teaches marked-up documents and said formats are in the form of XML files, and said production processor creates an XML:FO style sheet from said XML format file, creates an XML:FO file from said XML document and said style sheet, and generates an output file from said XML:FO file representing said user-requested document.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gebert with Reulein for the benefit of receiving as input a source document in the XML presentation language and an XML style sheet and transform the XML source document to an document including XSL-FO formatting objects (0023).

**Regarding dependent claim 12**, Reulein does not expressly disclose *the method of any one of claims 7 to 11, wherein said marked-up documents and said formats are in the form of XML files, and said generating step includes creating an XML:FO style sheet from said XML format file, creating an XML:FO file from said XML document and said style sheet, and generating an output file from said XML:FO file representing said user-requested document.*

Gebert teaches *marked-up documents and said formats are in the form of XML files, and said production processor creates an XML:FO style sheet from said XML format file, creates an XML:FO file from said XML document and said style sheet, and generates an output file from said XML:FO file representing said user-requested document* (0005-0008; 0014; 0023; 0030; 0042; Gebert teaches marked-up documents and said formats are in the form of XML files, and said production processor creates an XML:FO style sheet from said XML format file, creates an XML:FO file from said XML document and said style sheet, and generates an output file from said XML:FO file representing said user-requested document.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gebert with Reulein for the benefit of receiving as input a source document in the XML presentation language and an XML style sheet and transform the XML source document to an document including XSL-FO formatting objects (0023).

**NOTE**

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

**Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reulein in view of Gonzalez et al. (Pub. No. US 2002/0019786 A1; Filed: Jul. 19, 2001) (hereinafter “Gonzalez”).**

**Regarding independent claim 13,** Reulein discloses *a system for producing and distributing a document comprising:*

*a server site including a repository for storing documents in a marked-up form according to one or more mark-up schemas, each marked-up document having explicit the structural information corresponding to implicit structural information contained in a corresponding unmarked-up document (col. 2, lines 24-26; col. 3, lines 4-27 & 46-55; col.8, lines 4-11; col. 4, lines 12-15; col. 6, lines 49-63; col. 7, lines 14-30; Reulein discloses a repository for storing XML document component and XML completed document which can be assembled into a document. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-*

up/output document. Reulein also discloses a user browser-based interface / web browser based, which is used for selecting, viewing online in a viewable format and printing documents.), *a document format store for storing formats* (col. 2, lines 24-26; col. 3, lines 19-27; Reulein discloses a repository for storing XML document component and published document in one or form formats.), *a document format store for storing formats, and a document production processor for generating a user-requested document from said marked-up documents using a user-selected format, the generated user-requested document retaining said implicit structural information* (col. 4, lines 6-18 & 37-44; col. 6, lines 49-63; col. 7, lines 14-30; col. 8, lines 4-59; Reulein discloses selecting a publication format for the publication. The documents may be published in a variety of industry standards formats including postscript, PDF, HTML, XML and metacode. Reulein also discloses a repository for storing XML document component and XML completed document which can be assembled into a document. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up/output document.).

*a network to which said server site is in communication* (col. 3, lines 1-24; Fig. 1; Reulein discloses a network to which said server site is in communication.).

Reulein does not expressly disclose *a printing site to which said user requested document is sent via said network to be printed.*

Gonzalez teaches *a printing site to which said user requested document is sent via said network to be printed* (0013-0017; 0025; 0028; 0034; 0044; Gonzalez teaches routing customer orders received over an electronic network to a service provider (print service provider).).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

**Regarding dependent claim 14,** Reulein does not expressly disclose *wherein said printing site coincides with said user*.

Gonzalez teaches *wherein said printing site coincides with said user* (0013-0017; 0025; 0028; 0034; 0050; Gonzalez teaches print service providers comprising a gateway device configured to enable intelligent selection of a suitable print service provider for a given customer's printing requirements. Gonzalez also teaches the printing server provider being located in the vicinity of the delivery address specified in the order.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).



**Regarding independent claim 15**, Reulein discloses *a method for producing and distributing documents comprising the steps of:*

*marking-up documents according to a schema, each marked-up document having explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up document* (col. 4, lines 19-29; col. 7, line 14 – col. 8, line 47; Reulein discloses a DTD or schema is a standard blueprint for the permitted construction of a document. DTDs are used to validate proper assembly and structure of each document. Reulein also disclose the user editing/marking up a XML document/component. The XML components are mapped to the appropriate Document Type Definition (DTD) and/or schema. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up/output document.).

Reulein does not expressly disclose *receiving a customer order from a customer for a document over an electronic network, said customer order including formatting information;*

*applying a customer-selected format containing said formatting information to said marked-up document;*

*generating a customer-requested formatted document in electronic form using said customer-selected format, the generated customer-requested formatted document retaining said implicit structural information; and*

*transmitting said generated customer-requested formatted document over said electronic network.*

Gonzalez teaches *receiving a customer order from a customer for a document over an electronic network, said customer order including formatting information* (0050; Gonzalez teaches determining whether a printer service provider is able to deliver the required end printed product(s) (eg. those which did not support a given printing format, size of paper, media or ink type are discarded). Thus Gonzalez implicitly teaches receiving a customer order for a document over an electronic network, said order including formatting information.).

*applying a customer-selected format containing said formatting information to said marked-up document* (0050; Gonzalez teaches determining whether a printer service provider is able to deliver the required end printed product(s) (eg. those which did not support a given printing format, size of paper, media or ink type are discarded). Thus Gonzalez implicitly teaches applying a customer-selected format containing said formatting information to said marked-up document.).

*generating a customer-requested formatted document in electronic form using said customer-selected format, the generated customer-requested formatted document retaining said implicit structural information* (0050; Gonzalez teaches determining whether a printer service provider is able to deliver the required end printed product(s) (eg. those which did not support a given printing format, size of paper, media or ink type are discarded). Thus Gonzalez implicitly teaches generating a customer-requested

formatted document in electronic form using said format, the generated document retaining said implicit structural information.).

*transmitting said generated customer-requested formatted document over said electronic network* (0044; 0050; Gonzalez teaches transmitting said electronic document over said network.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

**Regarding dependent claim 16,** Reulein does not expressly disclose *the method of claim 15, wherein said transmitted document is received by said customer.*

Gonzalez teaches *wherein said transmitted document is received by said customer* (0058; Gonzalez teaches confirming that a print job has been completed and shipped to the customer.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

**Regarding dependent claim 17,** Reulein does not expressly disclose *the method of claim 15, wherein said transmitted document is received by a printing site that prints said transmitted document for forwarding to said customer.*

Gonzalez teaches *transmitted document is received by a printing site that prints said transmitted document for forwarding to said customer* (0050-0051; 0058; Gonzalez teaches following printing of the job the service provider may then arrange for the job to be shipped out to the customer.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011)

**Regarding dependent claim 18,** Reulein does not expressly disclose *the method of claim 17, wherein said customer order specifies a printing site being closest geographically to said customer.*

Gonzalez teaches *wherein said customer order specifies a printing site being closest geographically to said customer* (0058; Gonzalez teaches delivery of the print product specified in a print order to an address specified in a print order. Gonzalez also teaches consideration of geographical location of a given print service provider.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring

geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

**Regarding dependent claim 19**, Reulein does not expressly disclose *the method of claim 17, wherein said customer order includes said customer's geographical location, and the method includes the further step of choosing a printing site that is geographically closest to said customer.*

Gonzalez teaches *wherein said customer order includes said customer's geographical location, and the method includes the further step of choosing a printing site that is geographically closest to said customer* (0058; Gonzalez teaches delivery of the print product specified in a print order to an address specified in a print order. Gonzalez also teaches. Gonzalez also teaches the printing server provider being located in the vicinity of the delivery address specified in the order.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011)

**Regarding dependent claim 20**, Reulein does not expressly disclose *the method of claim 17, wherein said customer order includes the price the customer is willing to pay, and the method includes the further step of choosing a printing site that offers a production and transport cost that meets the price.*

Gonzalez teaches *wherein said customer order includes the price the customer is willing to pay, and the method includes the further step of choosing a printing site that offers a production and transport cost that meets the price* (0047; 0048; 0050; Gonzalez teaches a gateway device receiving a customer order or an inquiry from a customer as to how much a given printing job will cost preferably in terms of printing cost and shipping cost. Gonzalez further teaches the gateway device is configured to wait for a pre-determined time so as to receive a reply as to whether or not the quote is accepted.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

**Regarding dependent claim 21,** Reulein does not expressly disclose *the method of claim 17, wherein said customer order includes the length of time that the customer is willing to wait for the document, and the method further includes the step of choosing a printing site that can produce and transport the document to the customer to meet that wait time.*

Gonzalez teaches *wherein said customer order includes the length of time that the customer is willing to wait for the document, and the method further includes the step of choosing a printing site that can produce and transport the document to the customer to meet that wait time* (0050; Gonzalez teaches selecting printed service

providers which are suitable/available. Gonzalez also teaches selecting printed service providers able to deliver the goods within the time specified in the order.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Gonzalez with Reulein for the benefit requiring geographical criteria to be taking into account in terms of minimizing final price of a given customer print order (0011).

*NOTE*

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

***Response to Arguments***

Applicant's arguments filed 17 Dec. 2009 have been fully considered but they are not persuasive.

Previous **Claim Objections** are withdrawn.

Previous **Claim Rejections - 35 USC § 112** are withdrawn.

**Claim Rejections - 35 USC § 101**

Applicant argues *"The method steps recited in claim 7 result in physical transformations and are not all capable of mental execution. For example, the step of "marking-up a document according to a schema ...."cannot be performed mentally as it is not possible for a person to think about marking-up either an electronic or paper document and have such a document become marked-up. Likewise, "generating a user-requested document..." cannot be performed mentally. Such a generated document is physically created, for example, on an electronic display screen or printed on paper or other suitable medium. Claim 7 thus meets the requirements for statutory subject matter under 35 U.S.C. § 101 as interpreted by current federal case law. Applicants respectfully request the Office to reconsider and withdraw the statutory subject matter rejection."*

Even if the Examiner were to acquiesce Applicant's argument, which the Examiner does not, the Examiner notes the previous rejection recited *the steps recited in claim 7 may be performed manually and/or mentally*, not only mentally as Applicant argued. Thus, the recited method is not tied to a particular machine or apparatus. According, the recited method is nonstatutory subject matter. Therefore the rejection is maintained.

**Claim Rejections- 35 U.S.C. § 102**



*Applicant argues "Reulein et al. does not disclose or suggest "... each marked-up document having explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up document" as recited in amended claim 1."*

The Examiner disagrees.

Reulein discloses a repository for storing XML document component and XML completed document which can be assembled into a document. It has been established and well known in the art at XML files typically contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up/output document. Thus Reulein implicitly discloses *each marked-up document having explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up document.* (col. 2, lines 24-26; col. 3, lines 19-27; col. 4, lines 12-15; col. 6, lines 49-63; col. 7, lines 14-30)

*Applicant argues " While PDF and XML are structured document formats, there is no discussion in Reulein et al. regarding a "corresponding unmarked-up document" that has "implicit structural information" to which the explicit structures in the PDF document or the XML component corresponds."*

The Examiner disagrees.

Reulein discloses the publishing unit receives complete XML files from the assemble unit and published documents from the received XML in an industry standard format that may include postscript, PDF, HTML and metacode. Thus Reulein implicitly

*discloses a corresponding unmarked-up document that has implicit structural information to which the explicit structures in the PDF document or the XML component corresponds* (col. 4, lines 37-44; col. 5, lines 8-11).

Applicant arguments regarding independent claim 7 are substantial the same as those regarding independent claim 1, therefore the Examiner's respond is based on the same rationale as given above regarding independent claim 1.

Applicant argues "*Claims 2-4 and Claims 8-10 depend from claim 1 and claim 7 respectively and recite additional unique limitations. For at least these reasons, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 2-4.*"

The Examiner disagrees.

For the at least reason of their dependency to independent claim 1 and claim 7 respectively and based on the rationale given above, the rejection regarding dependent Claims 2-4 and Claims 8-10 are maintained.

**Claim Rejections- 35 U.S.C. § 103**

Applicant argues "*Hendrickson et al. does not disclose or suggest one or more of the formats recited in claims 5 and 11.*"

The Examiner disagrees.

Hendrickson explicitly teaches custom setting features which allow the user to change formatting parameters such as font type, font size, text justification, margins and other layout setting (0027-0030).

*Applicant argues "Claim 6 depends from claim 1 and claim 12 depends from claim 7. As discussed above, Reulein et al. does not disclose all of the limitations recited in independent claims 1 or 7. Gebert et al. does not make up the deficiencies noted above with respect to Reulein et al. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 6 and 12."*

The Examiner disagrees.

For the at least reason of their dependency to independent claim 1 and claim 7 respectively and based on the rationale given above, the rejections regarding dependent Claims 6 and 12 are maintained.

Applicant arguments regarding independent claims 13 and 15 are substantial the same as those regarding independent claims 1 and 7, therefore the Examiner's respond is based on the same rationale as given above regarding independent claims 1 and 7.

Applicant argues "Claim 14 depends from claim 13. As discussed above, Reulein et al. in view of Gonzales et al. does not disclose or make obvious all of the limitations recited in independent claim 13. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claim 14."

The Examiner disagrees.

For the at least reason of claim 14 dependency to independent claim 13 and based on the rationale given above regarding independent claim 13, the rejection regarding dependent claim 13 is maintained.

Applicant argues "Claims 16-21 depends from claim 15. As discussed above, Reulein et al. in view of Gonzales et al. does not disclose or make obvious all of the limitations recited in independent claim 15. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 16-21."

The Examiner disagrees.

For the at least reason of claims 16-21 dependency to independent claim 15 and based on the rationale given above regarding independent claim 15, the rejection regarding dependent claim 15 is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EXAMINER  
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14 March 2010